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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,494	02/07/2006	Julian Dakowski	BOUL0017	9341
26290 7590 05/05/2009 PATTERSON & SHERIDAN, L.L.P. 3040 POST OAK BOULEVARD SUITE 1500 HOUSTON, TX 77056				
EXAMINER				
COMSTOCK, NATHAN				
ART UNIT		PAPER NUMBER		
4132				
MAIL DATE		DELIVERY MODE		
05/05/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/567,494

**Applicant(s)**

DAKOWSKI, JULIAN

**Examiner**

NATHAN E. COMSTOCK

**Art Unit**

4132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7 February 2006 (Prelim. Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17, 19-22 and 26-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-17, 19-22 and 26-37 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

2. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-17, 20-22, and 26-33, drawn to a process for manufacturing an article.

Group II, claim(s) 19, drawn to a bar of soap.

Group III, claim(s) 34-34, drawn to a system for manufacturing an article.

3. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I and II share the common and/or corresponding technical features of a substrate and an overlay [member] that is at least one of translucent, semi-transparent, or transparent, the substrate having a contoured surface, and the overlay [member] being provided over at least a portion of said contoured surface. Groups I and III share the common and/or corresponding technical features of manufacturing an article comprising a substrate and an overlay [member] that is at least one of translucent, semi-transparent, or transparent, the substrate [member] having a contoured surface and the overlay [substrate] being provided over at least a portion of said contoured surface, a computer system to generate data corresponding to a three-dimensional image, and an apparatus to form a contoured surface. Groups II and III contain the common and/or corresponding technical features of a substrate and an overlay [member] that is at least one of translucent, semi-transparent, or

transparent, the substrate [member] having a contoured surface and the overlay being provided over at least a portion of said contoured surface.

4. However, in order to be considered a common special technical feature, any such feature must be novel and non-obvious. The above described technical features are not novel and non-obvious. UK Pat. App. Pub. GB 2376915 discloses the manufacture of an article comprising a substrate (variable height manufactured surface 902, page 3, lines 28-30, FIG. 4) and an overlay (epoxy resin/enamel hardener mixture 900, page 3, lines 28-30, FIG.4) that is at least one of translucent, semi-transparent, or transparent (page 2, lines 3-4: the epoxy resin is clear, and the enamel hardener is translucent), the substrate having a contoured surface (page 3, lines 28-30, FIG. 4, surface 902 is a variable height surface) and the overlay being provided over at least a portion of said contoured surface (page 4, lines 22-25; the epoxy resin is mixed with an enamel hardener and poured over the lithophane model in cold liquid form, and then left to set; this creates a surface finish), a computer system to generate data corresponding to a three dimensional image (page 3, lines 12-23, an image file is created by a digital camera or photograph scanner, and each point is assigned a specific height depending on the light transmission necessary at that point to replicate the original photographic image), and an apparatus to form a contoured surface (page 3, lines 1-4, translucent model is made using a thermojet [3D printer] or CNC milling machine tool).

5. Because all of the common technical features between groups I and II, groups I and III, and groups II and III are disclosed within the prior art, such common technical features cannot be special technical features under PCT Rule 13.2. As a result, the claims corresponding to Groups I, II, and III lack unity of invention.

6. A telephone call was made to Applicant's representative, Joseph Stevens, on April 14, 2009 to request an oral election to the above restriction requirement, but did not result in an election being made.

7. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

8. The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

9. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

10. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

#### CONCLUSION

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN E. COMSTOCK whose telephone number is (571) 270-1133. The examiner can normally be reached on Monday through Thursday, 8am-5pm Eastern Standard Time.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael LaVilla can be reached on (571) 272-1539. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N.E.C./  
Nathan E. Comstock  
Patent Examiner, Art Unit 4132  
29 April 2009

**/Michael La Villa/  
Michael La Villa  
Supervisory Patent Examiner, Art Unit 4132  
6 May 2009**